

No. 12633

IN THE

United States Court of Appeals

FOR THE NINTH CIRCUIT

DAY-BRITE LIGHTING, INC., a corporation,

Appellant,

vs.

RUBY LIGHTING CORPORATION, a corporation,

Appellee.

BRIEF FOR APPELLEE.

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FILED
DEC 1 1951
PARKER & COMPANY

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BRIEF FOR APPELLEE.

INTRODUCTION.

Appellant, Day-Brite Lighting, Inc. (plaintiff below), has appealed from a judgment rendered by the United States District Court for the Southern District of California, holding appellee, Ruby Lighting Corporation (defendant below) not guilty of infringement of two patents for design on fluorescent lighting fixtures and not guilty of a belated charge of unfair competition.

It is submitted that the judgment of the District Court must be sustained on the facts and on the applicable law and authorities. The matter is simple and clear-cut and defendant presents a short brief which sticks to the facts and the law, without oratory, in the hope that such factual presentation will assist this Court in the review of the case and the affirmation of the judgment.

NOTE: The parties shall be referred to as plaintiff and defendant. The references to the printed record, including Vol. II of Exhibits, shall be by R. followed by page number. Emphasized matter in decisions is by defendant.

BRIEF STATEMENT OF THE CASE.

Appellant, plaintiff below, a Missouri corporation, manufactures about one-quarter of all of the fluorescent lighting fixtures in the United States [R. 160] and among others, owns design patents No. D138,990 and No. D143,641 [Plaintiff's Exhibits 3 and 4] here in suit and a mechanical patent No. 2,411,952 [Plaintiff's Exhibit 5, R. 348] which describes the construction used in plaintiff's fluorescent fixture sold under the name "VIZ-AID" [Plaintiff's Exhibit 15].

Defendant is a California corporation and its president and principal stockholder, Ben Ruby, started working in the lighting fixture industry in 1915 [R. 221] and organized his first lighting fixture business in 1925 [R. 222]. Mr. Ruby is thoroughly familiar with manufacturing procedures and the desires of the trade with respect to lighting fixtures. Defendant's accused fixture is sold under the name "PARAMOUNT" [Exhibits 14 and 15]. Defendant's fixture employs a different construction than that used by plaintiff.

Defendant was originally charged with infringement of the mechanical construction patent No. 2,411,952 and the two design patents [Finding of Fact 2, R. 25, 95, 105]. Later, plaintiff filed its complaint charging defendant with infringement of the two design patents only. One year and nine months later, during trial, and at the conclusion of plaintiff's case, plaintiff filed a "First Amendment to Complaint" [R. 16] charging defendant with unfair competition. Defendant admits jurisdiction. Defendant denies infringement and any acts of unfair competition. Defendant, in its answer, denied validity, but the District Court did not decide this issue.

Both plaintiff's and defendant's lighting fixtures are designed to receive and use fluorescent tubes not invented by plaintiff [R. 54]. The fixtures are commercial fixtures built to receive standard, forty-eight-inch fluorescent tubes and as a result, the overall length of the fixture is a little more than forty-eight inches [R. 92]. Plaintiff's and defendant's fixtures follow the teachings of the prior art and use louvered bottoms to prevent glare, inclined translucent side panels, and metal ends with step-downs to permit light to be cast toward the ceiling. These fixtures are sold to Federal, State, County and City purchasing officials and their engineers, and to architects and wholesale jobbers [R. 238], generally on bids which specify performance characteristics but not ornamentation [R. 185, 224-225, 241, 242]. These are commercial fixtures and are not sold to individual householders.

Design patents are limited by statute to the protection of ornamentation and cannot cover functional elements, nor those shapes and forms which are common to a class of devices.

The Court properly found that the two design patents are of limited scope [Judgment, items 2 and 3, R. 32] and the Findings of Fact clearly point out that the design patents must be limited in view of the prior art [Findings 3, 4, 5, 6, and 7, R. 26-28]. Although doubt was expressed by the Trial Court as to the validity of the two design patents, the Court did not hold them invalid, because the matter was disposed of by the holding of non-infringement.

The Court properly found that the patents were not infringed [Judgment, item 4, R. 33] and Findings of Fact 10, 11 and 14 compel the conclusion of non-infringement. Plaintiff does not attack these findings.

The Trial Court also properly found that defendant was not guilty of unfair competition [Judgment, item 5, R. 33], and Findings 12, 13 and 14 clearly require such holding. This defendant has the right to make lighting fixtures, using prior art shapes and those forms which are necessary for proper light distribution.

The Trial Court, having observed the witnesses and exhibits, and being familiar with the manner in which the case was conducted during full trial, awarded costs and attorneys' fees to defendant. This was not an abuse of discretion.

SUMMARY OF DEFENDANT'S ARGUMENT.

It is submitted that no grounds exist upon which the judgment of the Trial Court can be justifiably reversed.

1. Design patents must be limited to ornamentation; the enabling statute (35 U. S. C. 73; R. S. 4929; 53 Stat. 1212) distinguishes design patents from mechanical patents (authorized by 35 U. S. C. 31) by limiting design patents to those which are directed to a "new, original and ornamental design," leaving out of the statute the words of utility and usefulness which characterize mechanical patents.
2. Design patents do not and cannot cover functional or utilitarian features for the basic reasons stated above.
3. The prior art in this case (not considered by the Patent Office in granting the design patents) and the file history limitations necessitate the imposition of but very narrow scope to the design patents in suit. If not so limited, the design patents are invalid.

4. Defendant does not use the ornamentation shown in the patents and does not infringe. Defendant's fixtures are functional and follow the teachings of the prior art [Finding 6, R. 27].
5. Plaintiff does not use, in its own VIZ-AID fixture, the ornamental elements of the design patents in suit. Plaintiff uses a mechanical construction which is covered by patent No. 2,411,952 not in suit. The so-called "commercial success" of plaintiff's VIZ-AID fixture is not attributable to the design patents.
6. Plaintiff has not shown that there is any secondary meaning to the form of its fixtures or that the public recognizes such form as indicating origin with plaintiff. There is **no evidence** of confusion and **no evidence** of palming off. There is no unfair competition.
7. The Trial Court, in the exercise of its discretion, properly awarded costs and attorneys' fees to defendant, because of the unjustified charges made by plaintiff and the belated charge of unfair competition, referred to in Finding of Fact 2 [R. 25-26].

PLAINTIFF DOES NOT CONTEND THAT THE FINDINGS OF FACT ARE IN ERROR. The facts compel the judgment reached by the Trial Court.

"Nowhere in appellant's brief is there a contention that the District Court's findings are erroneous; instead the argument is directed to the Trial Court's failure to find that the enumerated concepts constituted invention."

R. G. Le Tournau Inc. v. Garwood Industries.
(C. C. A. 9), 151 F. 2d 432.

FIXTURES ARE DESIGNED FOR LIGHTING EFFICIENCY.

In the old days of candle light and gaslight, the fixture consisted of a shield to protect the candle flame from the wind. With the advent of incandescent light globes, fixtures were devised to properly distribute the light in all directions and translucent materials were used to prevent the glare of the intense light source. About twenty-five or thirty years ago the illumination engineers established the **functional shape** of a fixture for most effective light distribution, and your Honors probably have had such fixtures in your homes for at least twenty years. This fixture is shown in Defendant's Exhibit L, last page of the book of exhibits here [R. 475].

Plate I compares the profile of this old fixture with the profile of defendant's fixture and identifies the functions of the sides, bottom and upstanding portion. The profile or contour imparts efficiency in distribution of light to the fixture.

The commercial fluorescent fixtures made by plaintiff and defendant are sold on the basis of efficiency.

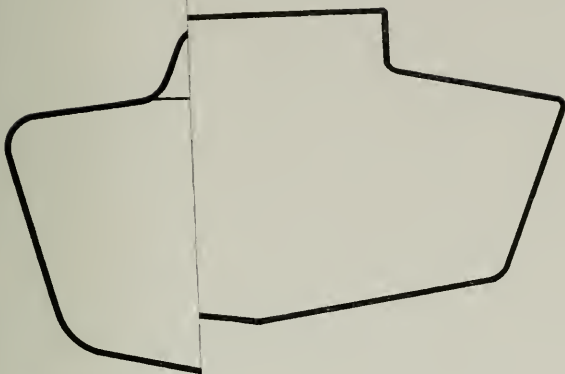
"Q. In selling fluorescent lighting fixtures, what do you find to be the important criterion or criteria which your purchasers seem to be interested in?

The Witness: If I had to phrase it in one word, I would say illumination efficiency" [R. 238].

Plaintiff's advertising [Exhibits 7 and 8] stresses "functionally designed" and "optically engineered." A great many prior art lighting fixtures employ the same functional arrangements as those shown in Defendant's Exhibit L. See, for example, R. 385, 389, 397, 399, 405, 412, 417, 424, 443, 444, 447, 452, 456, 460, 469, 470, 471.

Profi
Prior
Exhi

Profile of
Defendant's
Fixture



P
P
E

Profile of
Plaintiff's
Fixture



PLATE I.

Profile of
Prior Art Fixture
Exhibit L [R. 475]

Profile of
Defendant's
Fixture

Upstanding Portion
Functions to Space

Fixture From
Ceiling and
Permits Light to
Illuminate Ceiling

Inclined Sides
Function to
Direct Light
Angularly to
Side

Inclined Bottom
Functions to
Diffuse Light
Downwardly

Profile of
Prior Art Fixture
Exhibit L [R. 475]

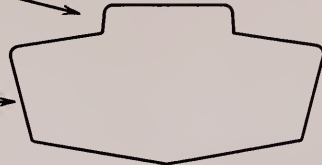
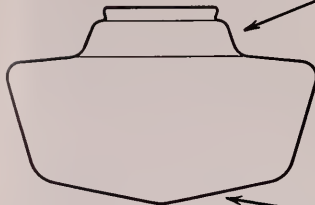
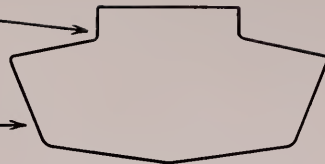
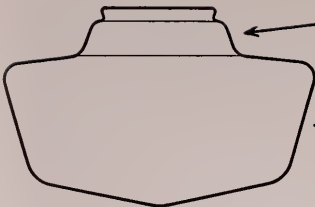
Profile of
Plaintiff's
Fixture

Upstanding Portion
Functions to Space

Fixture From
Ceiling and
Permits Light to
Illuminate Ceiling

Inclined Sides
Function to
Direct Light
Angularly to
Side

Inclined Bottom
Functions to
Diffuse Light
Downwardly



In these lighting fixtures the *purpose* of the inclined side panels made of translucent material is to emit light angularly downwardly, and to the side [Kaepfel, R. 99; Grossman, R. 248-249]. The transverse and longitudinal louvers in the bottom are for the *purpose* of shielding the lamp from the eye of the viewer [Kaepfel, R. 99] and are common in the prior art [R. 247]. The step-down end permits the light to be thrown up on the ceiling [R. 103] and the prior art publications clearly state that this prevents objectionable ceiling contrasts [R. 245-246].

Mr. Grossman, an electrical engineer in the illumination field, who has had extensive experience in working on department store illumination, assisting buyers in the selection of equipment, etc., reviewed the prior art and pointed out that the literature taught the *purpose and function* of all these elements. For example, Defendant's Exhibit I-21 entitled "A Review of Fluorescent Luminaire Design," printed in 1940, on page 6 [R. 452], shows a design having a step-down end, a V-shaped louver and transverse louvers, and states

"A. * * * 'The plastic sides and central member furnish shielding for crosswise view. The louvers shield for lengthwise view. The design of the upper part of the reflector is such as to direct light to the ceiling, thus eliminating objectionable ceiling contrasts'" [R. 245].

Mr. Grossman explained "ceiling contrasts" as follows:

"A. If the fixture is mounted as, for example, is the one in the court room, and were to be lit up and had a sharp contrasting differentiation between the brightness of the fixture itself and the ceiling, it would tend to become an object of glare to the eyes of a person that was in the room and using that fixture" [R. 245].

The step-down end is “a requirement in fixtures of this nature” [R. 246], since without it one would not get acceptable distribution of light [R. 247]. The fixture illustrated in the lower right portion on page 14 of Exhibit I-21 [R. 460] is substantially identical to defendant’s fixture [R. 249].

The length of the fixture must be sufficient to accommodate a forty-eight inch fluorescent lamp tube [R. 92] but should not be much longer, because then uniform lighting is not obtained [R. 127, 247], particularly when these fixtures are placed in end-to-end relation.

Even the cut-out end ornamentation in defendant’s fixture is partly functional in that it allows some light to be thrown beyond the end of the fixture [R. 250].

The evidence establishes that the angularity of the sides, the step-down end and the baffled bottom are **functional elements necessary to distribute light**. These elements are old in the art.

A design patent on a fixture cannot cover these functional and utilitarian features any more than a design patent on a spoon could cover the combination of a handle with a bowl portion at one end; such patent could only cover the *ornamentation* applied to the handle.

“* * * Infringement therefore must lie in the details of the design rather than in the general contour, just as infringement of a design for a spoon would lie in the particular design rather than in the general contour of a spoon.”

Lightolier Company v. Artistic Brass & Bronze Works, Inc., et al., 15 Fed. Supp. 323 at 324, affirmed 84 F. 2d 1007.

“The Acts of Congress, which authorize the grant of patents for designs were plainly intended to give

encouragement to *decorative arts*. They contemplate not so much utility as appearance, and that, not as an abstract impression or picture, but an aspect given to those objects mentioned in the Acts.”

Gorham Mfg. Co. v. White, 14 Wall. (81 U. S.) 511, 524, 20 L. Ed. 731.

“Patents for designs are intended to apply to matters of *ornament*, in which the utility depends upon the pleasing effect imparted to the eye, and not upon any new function * * *. Design patents refer to appearances, not utility. Their object is to encourage works of art and decoration which appeal to the eye, to the aesthetic emotions, to the beautiful.”

Rowe v. Blodgett & Clapp Co., 112 Fed. 61.

IT IS FUNDAMENTAL THAT DESIGN PATENTS MUST BE LIMITED TO ORNAMENTATION AND CANNOT COVER FUNCTIONAL FEATURES.

Plate I clearly shows that the end view or profile of plaintiff's design patents (as indicated by the outlines of Figs. 2 of the patents) are substantially identical to the profile of the old fixture, Exhibit L [R. 475]. This same profile is shown in numerous prior fixtures illustrated in defendant's Exhibit I. This contour or profile is functional and cannot be the subject matter of a design patent, because design patents are limited to ornamentation.

This Court has correctly stated:

“* * * so that the attempt to patent a mechanical function under cover of a design patent would lead to a perversion of the purposes of the statute.”

Majestic Electric Development Co. v. Westinghouse Electric & Mfg. Co., 267 Fed. 676 at 678 (C. C. A. 9).

“A design patent cannot be used to monopolize functional features which cannot be protected by a mechanical patent. *Baker v. Hughes-Evans Co.*, 270 Fed. 97; *Strause Gas Iron Co. v. William M. Crane Co.*, 235 Fed. 126; *North British Rubber Co., Ltd. v. Racine Rubber Tire Co. of New York, Inc.*, 271 Fed. 936; *Weisgerber v. Clowney*, 131 Fed. 477; *Pashek v. Dunlop Tire & Rubber Co.*, 8 F. (2) 640.”

Rowley v. Tressenberg et al., 37 Fed. Supp. 90 at 92, affirmed 123 F. 2d 844.

“* * * To hold that general configuration made necessary by function must give to a patented design such breadth as to include everything of similar configuration, would be to subvert the purpose of the law, which is to promote the decorative arts rather than to effectuate it.”

Applied Arts Corp. v. Grand Rapids Metalcraft Corp., 67 F. 2d 428 (C. C. A. 6).

“* * * It has been held that a design patent cannot properly be obtained on the shape of a device which necessarily results from its mechanical parts.
* * * A statement pertinent to the instant situation was made in *Applied Arts Corp. v. Grand Rapids Metalcraft Corp.*, 67 F. 2d 428, wherein the court in discussing the design before it stated (page 430):

“‘In the main its configuration is made imperative by the elements which it combines and by the utilitarian purpose of the device. It was certainly not the intent of the law to grant monopoly to purely conventional design which is in itself little more than a necessary response to the purpose of the article designed.’”

Circle S. Products Co. v. Powell Products, Inc., et al., 174 F. 2d 562 at 564 (C. C. A. 7).

“It is well settled that design patents should issue only upon ornamental or aesthetic features of a device, and cannot dominate functional or utilitarian features.”

Connecticut Paper Products Inc. v. New York Paper Company, 39 Fed. Supp. 127 at 134.

“* * * Furthermore, it has been held that a purely functional design is not patentable. *S. Dresner & Son, Inc. v. Doppelt, et al.*, 120 F. 2d 50; *Applied Arts Corp. v. Grand Rapids Metalcraft Corp.*, 67 F. 2d 428, 430.

“* * * The ampule being functional, it is difficult to perceive how its mere configuration could be other than functional.”

Smith v. Dental Products Co., Inc. et al., 140 F. 2d 140 at 153 (C. C. A. 7) cert. den. 64 S. Ct. 1146, 322 U. S. 743.

“* * * But the invention must relate to the design and be distinguishable from that which contrived the mechanical product for commercial purposes.”

North British Rubber Co., Ltd. v. Racine Rubber Tire Co. of New York, Inc., 271 Fed. 936 at 938.

These rules were properly applied by the District Court. The only *ornamentation* shown in patent No. D143,641 is the round bead at the bottom of the V-shaped louver and this is **not used** by defendant. The only *ornamentation* shown in patent No. D138,990 is the specific design on the end consisting of the zig-zag, the outstanding trapezoidal housing cover and the recess and hemispherical boss therein. These are **not used** by defendant.

PATENT NO. D143,641 [EXHIBIT 4; R. 343] IS
LIMITED TO DETAILS BY FILE HISTORY
LIMITATIONS AND BY THE PRIOR ART.

The application for this patent was filed on July 28, 1944, and such application was rejected by the Patent Office on but a single reference, the "Challenger 77" fixture [Exhibit 9-H].

Applicants Biller and Kaepfel admitted that there was no novelty in their arrangement of the bottom of their louvers, stating on February 12, 1945:

"The 'Challenger' fixture, like applicants' fixture, has a bottom light-emitting opening provided with a louver construction including a central louver and a plurality of cross louvers." [R. 327.]

Patent No. D143,641 cannot be said to cover any and all combinations of longitudinal and transverse louvers because of this admission and because defendant's Exhibit I shows numerous prior art fixtures including louvers and baffles [R. 397, 399, 405, 412, 424, 443, 444, 447, 452, 454, 456, 469, 470, 471].

Biller and Kaepfel specifically limited their purported contribution to a V-shaped longitudinal louver which

"* * * comprises upwardly diverging side walls connected by a longitudinal bottom bead or rib of circular cross section." [R. 327.]

Although they stressed this as an *ornamental* feature to the Patent Office, Kaepfel admitted on the stand that it was purely *utilitarian*.

"Q. What was the reason for the existence of that bead on the V-shaped louver? A. The bead came

into—was used in production for fastening the ends of the fixture to the longitudinal louver by means of a thread-cutting screw through the end plates.

Q. Did that circular bead on the V-shaped longitudinal louver contribute to its appealing appearance, in your opinion? A. No, sir.” [R. 68.]

Later, when the Patent Office again rejected their application, the applicants further limited their invention to a V-shaped louver made of “specular metal” [R. 330] and thereby distinguished from the white painted louvers such as are used by defendant here. Furthermore, applicants limited themselves to the use of “notched upper edges” on their cross louvers, stating that these notches are reflected in the specular sides of the V-shaped louver [R. 331].

Plaintiff is now estopped from claiming that the bead on the bottom of the V-shaped louver, shown in their patents, the use of specular metal and the notches in the upper edge of their cross louvers or baffles are not essential. They are the essential elements which caused the Patent Office to issue the patent. Kaeppel, one of the patentees, testified that the round bead is essential and had utility [R. 68, 112]. Since the head has utility, it was functional and not a proper element of a design patent.

The District Court correctly found that Patent D143,641 was limited to these details [Finding of Fact 3; R. 26]. The same details and limitations appear in Patent D138,990. Defendant **does not use** these details [Finding of Fact 10; R. 29].

PATENT NO. D138,990 MUST BE LIMITED TO
THE SPECIFIC ORNAMENTATION ON
THE END.

The only reference cited by the Patent Office in acting on this application was the "Challenger 77" fixture [R. 309].

It is fundamental that of two patents on the same subject, at least one of them must be invalid, as otherwise there is double patenting. Plaintiff admits in its brief that here we have "two patents upon a single louvered fluorescent lighting fixture" and stresses this anomalous situation in the headnote of page 32 of the brief.

"Only one valid, original patent can be granted to an inventor of one invention, and if a plurality of such patents are thus granted, all except the first are void. (Suffolk v. Hayden, 3 Wall. (70 U. S.) 315, 319, 18 L. Ed. 76; Miller v. Eagle Co., 151 U. S. 186, 197, 38 L. Ed. 121; Am. Steel Foundries v. Laughlin, 30 F. (2) 139, 142 (CCA 7 1928)."

Walker on Patents, Deller's Edition, page 1279.

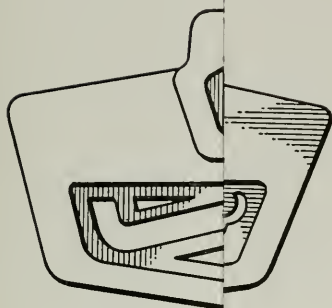
"Patentee cannot include in a later patent any invention described in a prior one."

Farris v. Patsy Frock & Romper Co., 273 Fed. 900 (C. C. A. 9).

Patent No. D138,990 **cannot** cover the longitudinally extending baffle with its rounded beaded end nor the transverse baffles, because these elements are covered by the earlier filed patent No. D143,641. The invention, if any,

P
PAT

Face



Face

Louver



Louver

End
Section

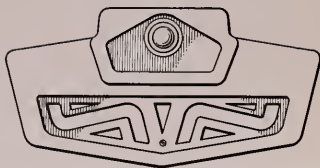
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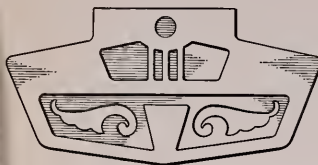
PLAINTIFF'S
PATENT D-138,990

DEFENDANT'S
FIXTURE

Face



Face



Different Design

Louver



No Bead



Louver

End
Section



Raised

Two
Piece

Flat

Single
Casting

End
Section



lies in the particular zig-zag ornamentation on the end of the device and, as stressed by the plaintiff, in the three parallel bars which connect the upper and lower rails of the inclined side panel. But the prior art clearly disclosed the use of one, two and three bars midway of an inclined side panel [see R. 385, 387, 395, 443, 456, 460, 471]. There is **no novelty** in such placement of bars.

The configuration of the end face of patent No. D138,990 in comparison with the end face used by defendant's "PARAMOUNT" fixture is shown on plate II. **That the design used by defendant is totally different was admitted** [R. 143, 113]. A tabulation of differences appears in the record, Vol. II, page 473. As correctly held by the District Court, if patent No. D138,990 is valid, it is not infringed, because **defendant does not use** the zig-zag design to which the patent is limited.

A comparison of Fig. 2 of patent No. 2,411,952 [R. 348] and patent No. D138,990 shows that the contours are identical, even to the raised, upper trapezoidal portion of the end. If Biller is the *sole* inventor of Fig. 2 of patent No. 2,411,952 and Biller and Kaepfel are *joint* inventors of patent No. D138,990, then obviously the only contribution made by Kaepfel was the zig-zag decoration. This emphasizes the fact that patent No. D138,990 must be limited to the specific zig-zag illustrated in the patent. Any attempt to cover the inclined sides, the step-down end or other functional features would necessitate holding the patent invalid, on the further ground that it was not issued to the true inventor.

DESIGN PATENTS MUST INVOLVE INVENTION. SINCE THE DESIGN OF THE PATENTS IN SUIT IS INSIGNIFICANT, THE PATENTS MUST BE STRICTLY LIMITED.

The District Court did not hold the design patents valid, but stated that if valid they were not infringed. Although the issue of validity is not directly in issue, the *quantum of invention* shown by the patentees should be considered. Invention is necessary as was stated by this Court in *Hammond v. Stockton Combined Harvester & Agricultural Works*, 70 Fed. 716 (cert. denied 16 S. Ct. 1202) and in later cases.

"It is well settled that a design patent must be the product of invention if it is to be valid. *Neufeld-Furst & Co. v. Jay-Day Frocks*, 2 Cir., 112 F. 2d 715; *In re Griffith*, C. C. P. A., 86 F. 2d 405. It will not suffice merely to show that the design is novel, ornamental, or pleasing in appearance. *Gold Seal Importers v. Morris White Fashions*, 2 Cir., 124 F. 2d 141. It must reveal a greater skill than that exercised by the ordinary designer who is chargeable with knowledge of the prior art. *Zangerle & Peterson Co. v. Venice Furniture Novelty Mfg. Co.*, 7 Cir., 133 F. 2d 266; *In re Eppinger*, C. C. P. A., 94 F. 2d 401. In short, the test is whether the design involved 'a step beyond the prior art requiring what is termed "inventive genius." ' *A. C. Gilbert Co. v. Shemitz*, 2 Cir., 45 F. 2d 98, 99. So measured, plaintiff's patent must fail."

General Time Instruments Corp. v. U. S. Time Corp., 165 F. 2d 853, 854 (C. C. A. 2), cert. denied 68 S. Ct. 1515, 334 U. S. 846.

Was it invention of an ornamental design to put a round bead on the end of the V-shaped louver, when such round bead was used as an attachment means and not as decoration? [R. 112]. Can a design patent on such invention be given any scope?

Was it “invention” to provide a zig-zag “doodle” on the end of the fixture? Can a design patent on such a simple, commonplace design be given any scope?

If it is assumed that these simple departures from the prior art constituted invention, then the patents must be **limited** to exactly what they show in their drawings.

**THE DESIGN PATENTS IN SUIT MUST BE
STRICTLY CONSTRUED BECAUSE THE
PRESUMPTION OF VALIDITY IS OVER-
THROWN BY PRIOR ART.**

Plaintiff admits that the patents in suit were issued by the Patent Office after citation of only one prior publication, namely, the “Challenger 77” reference. The Patent Office did not consider the numerous prior patents, publications and fixtures shown in Exhibit I [R. 383, 471]. In view of these prior fixtures, which show that it was common practice to use inclined sides, step-down ends, louvered bottoms, and cut-outs in the end portions of fixtures, the presumption of validity no longer attaches to the design patents in suit, and the scope of the patents must be **limited** so as not to permit these design patents to cover what is in the prior art.

“* * * But the presumption is overthrown beyond all reasonable doubt by the disclosures in evi-

dence before this court which were unknown and undisclosed to the Patent Office. *Alexander Anderson, Inc. v. Eastman*, 16 Fed. Supp. 515."

Barkeij v. Ford Motor Company, 22 Fed. Supp. 1001.

To the same effect, see *McClintock v. Gleason* (C. C. A. 9), 94 F. 2d 115; *Sidney Hollis Boynton v. Chicago Hardware Foundry Co.* (C. C. A. 7), 77 F. 2d 799, and *Mettler v. Peabody Engineering Corp., et al.*, 77 F. 2d 56 at 58 (C. C. A. 9), wherein the Court stated:

"The presumption of validity which attends the issuance of Letters Patent by the Patent Office is overcome in this case by the clear evidence of anticipation in the prior art which was not cited or considered by the Patent Office when the application for appellant's patent was passed on. See *Elliott & Co. v. Youngstown Car Mfg. Co.*, 181 Fed. 346 (C. C. A. 3); *American Soda Fountain Co. et al. v. Sample*, 130 Fed. 145 (C. C. A. 3)."

When a presumption of validity does not exist, it cannot be buttressed by obtaining two patents on the same subject.

THE LAW REQUIRES THAT THE DESIGN PATENTS IN SUIT MUST BE LIMITED TO THEIR PRECISE SHOWINGS.

Design patents differ from patents on useful machines in that design patents have no descriptive matter. Ornamental designs would be difficult to describe, and reliance is placed upon the drawing. In the early case of *Zidell v. Dexter*, 262 Fed. 145, this Court held that the patentee of a design patent

“* * * must be held substantially to the design which he exhibits by his drawing.”

This rule is followed in all circuits.

“On the other hand, the plaintiff’s patent, which contains no written description of his design, must be construed as limited to substantially the pattern shown in his drawings (*Ashley v. Tatum Co.*, 186 Fed. 339), * * *. But if defendant’s changes result in producing a substantially different effect upon the eye, so that the two patterns are reasonably distinguishable, infringement will be avoided. *Zidell v. Dexter*, 262 F. 145; *Whiting Mfg. Co. v. Alvin Silver Co.*, *supra*.”

American Fabrics Co. v. Richmond Lace Works et al., 24 F. 2d 365 at 367.

“The plaintiff’s design is restricted to the disclosure of the drawings, since there is no written specification: *Ashley v. Samuel C. Tatum Co.*, 186 F. 339; *American Fabrics Co. v. Richmond Lace Works*, 24 F. 2d 365, at 367; *Scoville Mfg. Co. v. United*

States Electric Mfg. Corporation, 31 F. Supp. 115, at 119.

“Every element in the design must be deemed to be essential: Dixie-Vortex Co. v. Lily-Tulip Cup Corporation, 95 F. 2d 461 at 467.”

Forman v. American Express Company et al., 37 Fed. Supp. 82 at 83.

PATENT NO. D143,641 IS NOT INFRINGED.

The drawings of this patent clearly show

(a) the **round bead** at the bottom of the V-shaped louver, such bead being represented to the Patent Office as an important element [R. 327];

(b) that **specular metal** is to be used for the V-shaped louver (indicated by shaded areas in Fig. 1) [R. 330];

(c) the **curved indentations** in the upper edge of the transverse baffles [R. 331].

Defendant does not use these features. [Admitted by Kaepfel, R. 112.] Plate II clearly points out the differences and facilitates comparison. The District Judge, in Finding 10, found that defendant does not use the bead nor does defendant use specular metal. Plaintiff does not contest this finding.

There is **no infringement** of patent No. D143,641 nor of corresponding parts of patent No. D138,990.

PATENT NO. D138,990 IS NOT INFRINGED.

A comparison of the drawings of this patent with defendant's fixtures clearly shows that defendant does not use the zig-zag design. Plaintiff's own witnesses admitted that defendants' ornamentation was different [R. 142, 113]. Mr. Grossman listed all of the differences between plaintiff's and defendant's fixtures, and they appear in tabular form as Exhibit K [R. 473-474].

Non-infringement is so obvious that detailed discussion is unnecessary. Plaintiff cannot deny the facts. Finding of Fact 11 [R. 29] is a clear-cut statement which is uncontradicted by the evidence, and reads as follows:

"11. Defendant does not use, in its 'Paramount' fixtures exemplified by Exhibits 14 and 15, a zigzag design such as is shown in Letters Patent No. D-138,990; an entirely different design or ornamentation is used by defendant on its accused fixtures. Each of the step-down ends of defendant's fixtures are single castings which do not include a protruding upper portion. Defendant's fixtures do not employ the construction of plaintiff's fixtures and the louvered bottom is manipulated in a totally different manner. Defendant's fixtures, exemplified by Exhibits 14 and 15, employ forms and proportions which are common to lighting fixtures as a class and illustrated in prior art fixtures, and do not involve inventive change over the prior art."

The conclusion of law and judgment of non-infringement must be affirmed.

BY CHARGING DEFENDANT WITH UNFAIR COMPETITION, PLAINTIFF IS ATTEMPTING TO MONOPOLIZE NECESSARY AND FUNCTIONAL CONTOURS AND PROFILES OF LIGHTING FIXTURES.

Realizing that its design patents are not infringed, plaintiff is attempting to prevent defendant from making fixtures in which old, functional contours are used, by charging defendant with unfair competition. Defendant contends that anyone can make use of features which are necessary to the usefulness of the device. Anyone can use inclined, translucent sides to cast light downwardly and to the side, a step-down end to permit light to be emitted to the ceiling, and a louvered bottom to prevent glare.

“There is nothing about the article, as made and sold by the defendants, that is not necessary in the making and operation of such an instrument. *It is made in the form that it must be made in order to accomplish its purpose*, and, if the making in that form is any representation that the thing made came from the plaintiff, it is because of the extent to which the plaintiff had made and displayed and sold it before the defendants began.”

Marvel Co. v. Tullar Co. et al., 125 Fed. 829 at 830.

“The plaintiff has not the exclusive right to sell shredded wheat in the form of a pillow-shaped biscuit—the form in which the article became known to the public.

“* * * Moreover, the pillow-shape must be used for another reason. The evidence is persuasive that this form is functional—that the cost of the bis-

cuit would be increased and its high quality lessened if some other form were substituted for the pillow-shape.”

Kellogg Company v. National Biscuit Company,
305 U. S. 111 at 119 and 122.

“Development in a useful art is ordinarily toward effectiveness of operation and simplicity of form. Carriages, bicycles, automobiles, and many other things from diversity have approached *uniformity through the utilitarian impulse*. If one manufacturer should make an advance in effectiveness of operation, or in simplicity of form, or in utility of color; and if that advance did not entitle him to a monopoly by means of a machine or a process or a product or a design patent; and if by means of unfair trade suits he could shut out other manufacturers who plainly intended to share in the benefits of the unpatented utilities and in the trade that had been built up thereon, but who used on their products conspicuous nameplates containing unmistakably distinct trade-names, trade-marks, and names and addresses of makers, and in relation to whose products no instance of deception had occurred—he would be given gratuitously a monopoly more effective than that of the unobtainable patent in the ratio of eternity to seventeen years.”

Pope v. McCrum-Howell, 191 Fed. 979, 981 (C. C. A. 7).

“It is attempted to sustain the cause of action for unfair competition on the ground that the defendants’ fruit juice extractors closely resemble those of the complainant * * *. But there is no proof of palming off * * *. Moreover, the elements of the fruit juice extractor are so far functional that noth-

ing short of a clear danger of confusion would justify us in requiring a modification of the model. *Crescent Tool Co. v. Kilborn & Bishop Co.* (C. C. A.), 247 F. 299; *Miller Rubber Co. v. Behrend* (C. C. A.), 242 F. 515."

A. C. Gilbert Co. v. Shemitz, et al. (C. C. A. 2), 45 F. 2d 98 at 99-100.

"The complainant cannot obtain a monopoly for all time of perforated plates of the lengths having equidistant holes and intervening spaces which it first used. *These are functional features of the units of construction which any one is at liberty to use.*"

Meccano, Ltd., v. John Wanamaker, 250 Fed. 450 at 452 (C. C. A. 2).

Plaintiff does not have a patent on a lighting fixture having inclined side panels, a step-down end, and a lowered bottom. These are **necessary, functional features** which are common to all lighting fixtures and a **part of the prior art**. Defendant has the right to use these features. The use of such old features, necessary to perform the required functions, is not unfair competition. Counsel for plaintiff admitted that anyone can use such elements.

"Mr. Foster: * * * I think the separate parts of any patented design which have mechanical utility, they are free for use by anyone" [R. 286].

Chief Justice Holmes, in *Flagg Manufacturing Co. v. Holway*, 178 Mass. 83, 59 N. E. 667, considered a case involving zithers, those made by the defendant so closely resembling the plaintiff's in outline, arrangement of strings, and other features, that it was obviously an imi-

tation. Chief Justice Holmes held that the defendant had a right to imitate the appearance of the plaintiff's zither, stating:

"Both zithers are adapted for the use of patented sheets of music, but the zithers are not patented. Under such circumstances the defendant has the same right that the plaintiff has to manufacture instruments in the present form, to imitate the arrangement of the plaintiff's strings or the shape of the body. In the absence of a patent the freedom of manufacture cannot be cut down under the name of preventing unfair competition. * * * All that can be asked is that precautions shall be taken, so far as are consistent with the defendant's fundamental right to make and sell what he chooses, to prevent the deception which no doubt he desires to practice.

"It is true that a defendant's freedom of action with regard to some subsidiary matter of ornament or label may be restrained, although a right of the same nature with its freedom to determine the shape of the articles which it sells. But the label or ornament is a relatively small and incidental affair, which would not exist at all or at least would not exist in that shape but for the intent to deceive; whereas the instrument sold is made as it is, partly at least, because of a supposed or established desire of the public for instruments in that form. The defendant has the right to get the benefit of that desire even if created by the plaintiff. The only thing he has not the right to steal is the good will attaching to the plaintiff's personality, the benefit of the public's desire to have goods made by the plaintiff."

In commenting upon this case, Nims (the leading authority on unfair competition) stated:

“* * * But the fact that the demand for zithers has been created by the plaintiff will not put the case within the unfair competition rules, where the demand is for the article, not the personality.”

Nims on Unfair Business Competition, page 290.

It is submitted that to sustain the charge of unfair competition, plaintiff must prove (1) that the article sold by plaintiff has acquired a secondary meaning and its shape is recognized as meaning that the article is made by plaintiff; that the public associates the non-functional, distinctive elements of appearance with plaintiff as the source of the fixture; and (2) that defendant has actually sold and palmed off upon the purchasing public a slighting fixture made by defendant as and for plaintiff's fixture.

This Court has succinctly stated the rule as follows:

“* * * The law of unfair competition has resulted from the application of a simple proposition to the extension and modern development of manufacturing and merchandising. That principle may be expressed in the language used by the various courts when dealing with the subject of unfair competition, as follows: ‘That nobody has any right to represent his goods as the foods of somebody else.’ (Elgin Natl. Watch Co. v. Illinois Watch Co., 179 U. S. 665, 676.)”

Del Monte Special Food Company v. California Packing Corporation, 37 F. 2d 774 (C. C. A. 9).

Plaintiff has not proved secondary meaning nor palming off or deception. Plaintiff admitted that there was no evidence of secondary meaning.

“The Court: * * * And I think I can say parenthetically here there is no direct evidence.

Mr. Foster: None direct.

The Court: That any customer in the trade associates the plaintiff's name with this type of fixture.

Mr. Foster: I think that is true” [R. 290].

The District Court found that there was no proof of secondary meaning [Finding of Fact 12, R. 29]. The District Court found that there was no palming off [Finding of Fact 13, R. 30]. Plaintiff does not object to these findings and cannot point to evidence to the contrary.

The District Court correctly applied the law to these facts and properly concluded that defendant is not guilty of acts of unfair competition. Any other conclusion would be contrary to the authorities.

THE PURPORTED “COMMERCIAL SUCCESS” IS NOT ATTRIBUTABLE TO THE DESIGN SHOWN IN THE PATENTS.

Many pages of plaintiff's brief are devoted to commercial success, but this argument is fallacious for the following reasons:

1. The VIZ-AID fixture sold by plaintiff does not use the elements shown in the design patents. The VIZ-AID fixture **does not use** the characteristic round bead at the bottom of the V-shaped louver which is shown in both design patents in suit. The end of plaintiff's fixture does not include a recess (in the upper portion, constituting a cover for the ballast

housing) of the shape shown in patent D138,990. It does not use the hemispherical, concentrically ridged boss in such recess [R. 109].

2. The voluminous advertising of VIZ-AID fixtures is primarily directed to **mechanical features** which are covered by the mechanical patent No. 2,411,952. Many advertisements stress the snap-on enclosure whereby side panels, louvers and most of the ends can be dropped down and suspended from the ballast housing during relamping [R. 95, 175, 176; demonstrated by Kaepfel, R. 104; illustrated in Defendant's Exhibit A and Plaintiff's Exhibit 6K, R. 105]. This construction is covered by patent No. 2,411,952, Exhibit 5, R. 348. Plaintiff's witness admitted that **such construction is not used by defendant.**

“Q. That particular function or that particular arrangement, mechanical arrangement, cannot be found in the defendant's structure, can it? A. No.” [R. 176.]

3. VIZ-AID advertising stresses the light distribution characteristics of the fixture, which certainly is not covered by design patents [R. 158-159].
4. The VIZ-AID fixture, as sold, includes, as a part of its design, embossing on three parallel bars on each side panel. This embossing is not shown in patent D138,990 [R. 108-109].

Therefore the commercial success of the VIZ-AID fixture is not attributable to the design patents, but to extensive advertising and to mechanical construction covered by other patents, not in suit here. Plaintiff did not attempt to state what percentage of its advertising stressed

functional details and mechanical construction and what percentage was directed to aesthetics and appearance [R. 176], because all of it is directed to matters *not covered* by the design patents in suit.

The argument regarding commercial success must be ignored because it is not pertinent. The issues here cannot be decided by plaintiff's ability to spend over \$88,000 in advertising; any such approach would always necessitate judgment for the party with most money.

The authorities clearly hold that commercial success cannot supplant invention. **Commercial success cannot convert non-infringement into infringement.**

THE MATHEMATICAL DISCOURSE OF PROFESSOR DOUGHERTY IS FOUNDED ON FALLACY AND HAS NO BEARING HERE.

Plaintiff accuses defendant of infringing two patents; the issue is determined by applying the two design patents to defendant's structure.

Professor Dougherty did not do so. Instead, he compared plaintiff's commercial fixture with defendant's fixture. This is totally irrelevant because **plaintiff's commercial fixture does not embody what is shown in plaintiff's patents.**

Plaintiff's fixture does not use the round bead at the bottom of the V-shaped louver [R. 291]; plaintiff's fixture does not use the round protuberance in the recess of the cover plate at the end of the chassis [R. 109].

The Professor did not consider that defendant did not use the zig-zag design, and did not use the rounded bead on the V-shaped louver.

The entire premise of the mathematical exercise is therefore in error. Furthermore, the calculation of probabilities, as stated by Professor Dougherty, is based upon the assumption that each element [or marble in his example R. 132-133] is of exactly the same shape, weight and value. If not of the same value, then the mathematical method is not applicable, as admitted by the Professor [R. 141]. The Professor did not take into consideration that fact that prior art fixtures had inclined sides, step-down ends and louvered bottoms [R. 140]. He did not take into consideration that forty-eight inch tubes were common. These are old elements; they are common. He did admit, after looking at plaintiff's and defendants' fixtures

“Yes, I observe a difference in the appearance of the ornamental features, if that is what you have in mind” [R. 142].

That admission disposes of any contention that defendant infringes. If the ornamental features are different, defendant does not infringe.

THE BURDEN OF PROOF WAS UPON PLAINTIFF. PLAINTIFF DID NOT AND COULD NOT SHOW CONFUSION, DECEPTION OR PALMING OFF.

The commercial fixtures such as VIZ-AID and PARAMOUNT are not sold to housewives or the general public, but instead to engineers, purchasing agents for governmental bureaus, and architects. The fixtures are not dime store devices which are casually purchased without careful consideration; instead, the fixtures are sold on specifications as to light distribution, efficiency, etc. Defendant's fixtures, Exhibit 19, are sold under the name "PARAMOUNT."

Plaintiff could not and did not adduce testimony to show confusion, and failed to carry the burden of proof.

"* * * In establishing such charge of unfair competition, we are of the view that plaintiff must show more than slight confusion—it *must be proved that the defendants palmed off their goods for that of the plaintiff*, and such proof must be by clear preponderance of the evidence. *Soft-Lite Lens Co., Inc., v. Ritholz*, 301 Ill. App. 100, 105."

The Rytex Company v. Ryan, et al., 126 F. 2d 952 at 954 (C. C. A. 7).

"There is no showing in the record that any person purchased appellee's bait because of its shape, size or dimensions believing it to be the product of appellant. * * * There is an entire absence of proof showing that appellee's bait of the design in

question had been bought because the purchaser believed it originated with appellant rather than because they were useful articles with an attractive appearance.”

James Heddon's Sons v. Millsite Steel & Millsite Steel & Wire Works, Inc., 128 F. 2d 6 (C. C. A. 6).

“* * * However, the mere existence of possible confusion does not give rise to the right of injunction. As stated by Judge Learned Hand in *Crescent Tool Co. v. Kilborn & Bishop Co.*, 247 F. 299, 300 (C. C. A. 2):

“‘. . . It is apparent that it is an absolute condition to any relief whatever that the plaintiff in such cases show that the appearance of his wares has in fact come to mean that some particular person—the plaintiff may not be individually known—makes them, and that the public cares who does make them, and not merely for their appearance and structure.’”

The American Fork & Hoe Company v. Stampit Corporation (C. C. A. 6), 125 F. 2d 472 at 475.

“* * * Under the law of unfair competition a manufacturer is given protection for the distinctive dress or general appearance of his packages against a competitor who later enters the field with a device calculated to deceive the public and to enable the latter to palm off his goods for the goods of the former. *J. C. Penney Co. v. H. D. Lee Mercantile Co.*, 8 Cir., 120 F. 2d 949; *Queen Mfg. Co. v. Isaac Ginsberg & Bros., Inc.*, 8 Cir., 25 F. 2d 284. Here there is no evidence of confusion, deception or palming off, * * *. * * * The question of palming off, therefore, is one of probability only.

“* * * When the rule of ensemble and general appearance is applied, and the elements which are common to the trade, such as bottles and labels of some sort, are considered, the resemblance is not sufficient to warrant a reversal of the trial court’s judgment.”

The Seven Up Company v. Cheer Up Sales Company of St. Louis, Missouri, et al. (C. C. A. 8), 148 F. 2d 909 at 912.

To the same effect:

Wilharts v. Turco Products Inc., 164 F. 2d 731 (C. C. A. 7);

Ely Norris Safe Co. v. Mosler Safe Co., 62 F. 2d 524.

THE CASES CITED BY PLAINTIFF ON PAGES 35-42 OF PLAINTIFF’S OPENING BRIEF ARE NOT PERTINENT TO THE FACTS IN THE INSTANT CASE.

Upon analysis of the various cases cited by plaintiff, it will be found that, whenever the Court held that there had been unfair competition, there was evidence showing

- (1) that the article had acquired a **secondary meaning** and the public recognized the article as having its source with plaintiff;
- (2) that **non-functional**, decorative features had been copied;
- (3) that **actual deception** or palming off had occurred.

In the instant case there is no evidence of secondary meaning; defendant Ruby has not copied any decorative, non-functional features; and there is no evidence of deception.

Judge Learned Hand, in reviewing the various cases cited by plaintiff, while sitting in the Second Circuit in the case of *Crescent Tool Co. v. Kilborn & Bishop Co.*, 247 Fed. 299 (C. C. A. 2), stated at page 300:

“The cases of so-called ‘non-functional’ unfair competition, starting with the ‘coffee mill case,’ *Enterprise Mfg. Co. v. Landers, Frary & Clark*, 131 F. 240, 65 C. C. A. 587, are only instances of the doctrine of ‘secondary’ meaning. All of them presuppose that the appearance of the article, like its descriptive title in true cases of ‘secondary’ meaning, has become associated in the public mind with the first comer as manufacturer or source, and, if a second comer imitates the article exactly, that the public will believe his goods have come from the first, and will buy, in part, at least, because of that deception. Therefore it is apparent that it is an absolute condition to any relief whatever that the plaintiff in such cases show that the appearance of his wares has in fact come to mean that some particular person—the plaintiff may not be individually known—makes them, and that the public cares who does make them, and not merely for their appearance and structure. It will not be enough only to show how pleasing they are, because all the features of beauty or utility which commend them to the public are by hypotheses already in the public domain. The defendant has as much right to copy the ‘nonfunctional’ features of the article as any others, so long as they have not become associated with the plaintiff as manufacturer or source. The critical question of

fact at the outset always is whether the public is moved in any degree to buy the article because of its source and what are the features by which it distinguishes that source. Unless the plaintiff can answer this question he can take no step forward; no degree of imitation of details is actionable in its absence."

Furthermore, the *Rushmore v. Manhattan Screw* case, 163 Fed. 939, referred to by the plaintiff, was an appeal from an order granting a preliminary injunction, was not tried on the merits, contains a strong and logical dissent by Circuit Judge Noyes and commentary on this case indicates that the language of the decision is unfortunately general.

It is to be noted that in *Buckeye Incubator Co. v. Model Incubator Co.*, 237 Fed. 883, the Court found that the shape of the stove was *not* found in the prior art, "* * * nor was it shown that such shaping was necessary to the performance of its functions." (P. 886.) Here, the prior art shows that the contour is old and common to many fixtures. The record shows that the inclined side panels are **necessary** to direct light angularly downward, the step-down end is **necessary** to permit light to be cast upwardly onto the ceiling and prevent undesirable contrast and the louvered bottom is **necessary** to prevent glare.

Defendant Ruby's "PARAMOUNT" fixture resembles the fixture of the expired Mitchell patent [R. 389]. It uses the V-shaped louvers such as shown in Masterson [R. 397], or illustrated in the Luminaire publication [R. 452, 460]. It uses a step-down end as shown in Illumination Engineering [R. 444], Luminaire, page 14 [R. 460], and Ruby's own 1941 fixtures [R. 373, 377, 469].

THE ADOPTION OF THESE CONTOURS, INCLINED SIDES, LOUVERS, ETC., COMMON TO LIGHTING FIXTURES, DOES NOT AMOUNT TO UNFAIR COMPETITION.

“* * * any one was free to copy it so long as he did not attempt thereby to palm off his goods as those of complainant, and took due care to guard against any deception of the public into buying in the belief that it is purchasing complainant's goods. * * * *And it results from this principle that the adoption by one manufacturer of the characteristic features of another's product, common to articles of that class, does not of itself amount to unfair competition.*”

Rathbone, Sard & Co. v. Champion Steel Range Co., 189 Fed. 26 at 31 (C. C. A. 6).

“Both of the companies use similar bottles, boxes, and tins to contain the medicines prepared by them, and the cartons used to inclose them have a general correspondence in form and color. The labels on the containers and cartons are also of similar size and colors and have the same general style of letters. There is nothing unusual or distinctive in this dress of goods. Neither the use of the same colors, or of the same form of containing vessels, cartons, or labels, alone constitute unfair competition, when such features are in common use in the trade, and especially when these features serve purposes of utility, convenience, or attraction. *P. Lorillard Co. v. Peper*, 86 Fed. 956, 30 C. C. A. 496; *Globe-Wernicke Co. v. Fred Macey Co.*, 119 Fed. 696, 56 C. C. A. 304; *Marvel Co. v. Pearl*, 133 Fed. 160, 66 C. C. A. 226; *Sterling Remedy Co. v. Eureka Chemical & Manufacturing Co.*, 80 Fed. 105, 25 C. C. A. 314.”

Viazi Co. v. Vimedia Co., 245 Fed. 289 at 293.

It is submitted that the cases relied upon by plaintiff are not only distinguishable from the facts of the instant case for the reasons stated, but furthermore, fail to reflect the weight of authority and tenor of the decision of the Supreme Court of the United States, as expressed in *Kellogg Co. v. National Biscuit Co.*, 305 U. S. 111.

In that case, National Biscuit Company sued Kellogg for (1) unfair competition in selling a pillow-shaped breakfast food and (2) calling it "Shredded Wheat". Mr. Justice Brandeis delivered the opinion, stating that Kellogg:

"* * * contends that in honestly competing for a part of the market for shredded wheat it is exercising the common right freely to manufacture and sell an article of commerce unprotected by patent." (P. 116.)

On secondary meaning the Court stated:

"* * * There is no basis here for applying the doctrine of secondary meaning. The evidence shows only that due to the long period in which the plaintiff or its predecessor was the only manufacturer of the product, many people have come to associate the product, and as a consequence the name by which the product is generally known, with the plaintiff's factory at Niagara Falls. But to establish a trade name in the term 'shredded wheat' the plaintiff must show more than a subordinate meaning which applies to it. *It must show that the primary significance of the term in the minds of the consuming public is not the product but the producer.* This it has not done." (P. 118.)

On the right of all to use old forms, the Court stated:

"The plaintiff has not the exclusive right to sell shredded wheat in the form of a pillow-shaped biscuit

—the form in which the article became known to the public. That is the form in which shredded wheat was made under the basic patent. * * * Hence, upon expiration of the patents the form, as well as the name, was dedicated to the public. * * *

“Where an article may be manufactured by all, a particular manufacturer can no more assert exclusive rights in a form in which the public has become accustomed to see the article and which, in the minds of the public, is primarily associated with the article rather than a particular producer, than it can in the case of a name with similar connections in the public mind. *Kellogg Company was free to use the pillow-shaped form, subject only to the obligation to identify its product lest it be mistaken for that of the plaintiff.* (Pp. 119-120.)

“Moreover, the pillow-shape must be used for another reason. The evidence is persuasive that *this form is functional*—that the cost for the biscuit would be increased and its high quality lessened if some other form were substituted for the pillow-shape.” (P. 122.)

The *Kellogg* case reiterates the right of all to use common forms and to compete for business. In a more recent case, *Gum, Inc. v. Gummakers of America, Inc.*, 136 F. 2d 957 (C. C. A. 3), plaintiff packaged bubble gum in cylindrical form for ten years before defendant produced bubble gum, also in cylindrical form. The Court held that defendant had the right to make bubble gum of this particular shape, stating:

“Aside from the prohibition against infringing a patent, copyright or trade mark and except for the requirement, hereinafter discussed, that he must identify his product as his own, *any one has the right to manufacture and sell a product similar or even*

identical in appearance to the original product with which it competes unless the original product has become associated in the public mind with its producer. (P. 958.)

“From this evidence it would be possible to conclude that the plaintiff by its pioneer work in the field created the desire in the public for bubble gum having the appearance of Blony, that the defendant copied that appearance and profited by the public demand which the plaintiff had aroused. This evidence would not, however, justify a finding that the public associates with the plaintiff bubble gum having the appearance of Blony in the form in which it is marketed or that the public demand is for the plaintiff’s product as such.” (P. 960.)

In *The Zangerle & Peterson Company v. Venice Furniture Novelty Manufacturing Company*, 133 F. 2d 266 (C. C. A. 7), the Court stated:

“In the absence of actual ‘palming off’ or the existence of a secondary meaning in the trade, the copying by the defendant of the plaintiff’s unpatented design did not amount to unfair competition. Where no one has the exclusive right to the use of a design, all may use it with impunity, so long as the public is not misled in the methods of marketing the product.”

The correct rule of law is: That Defendant Ruby, in common with other manufacturers of lighting fixtures, has the right to use those shapes, angles, contours and materials which are **functionally necessary to properly distribute light**. Defendant’s only duty is to refrain from copying non-functional, decorative or ornamental, patented features, and from palming off its goods as the goods of plaintiff.

THE TRIAL COURT PROPERLY AWARDED DEFENDANT TAXABLE COSTS AND AT- TORNEYS' FEES.

Pursuant to 35 U. S. C. A. 70, the District Court awarded a portion only of the attorneys' fees actually incurred by defendant. The award of attorneys' fees is discretionary with the Trial Court. Senate Report No. 1502, June 14, 1946, adopted from a report of the House Committee on Patents, in discussing this provision stated:

"The provision is also made general so as to enable the court to prevent a gross injustice to an alleged infringer."

Long prior to the amendment of 35 U. S. C. A. 70 the courts have awarded attorneys' fees and costs in addition to the normal costs taxable as a matter of course, whenever it appeared that a party made unfounded representations, unnecessarily prolonged trial, took depositions unnecessarily, or otherwise placed an oppressive burden upon the opponent.

In the instant case, the plaintiff, one of the most powerful manufacturers of lighting fixtures, and who apparently manufactures about one-fourth of the nation's output in fluorescent tube fixtures, sued a small manufacturer. It is submitted that plaintiff's counsel have gone to great lengths in aggressively establishing its position; plaintiff has gone to the length of obtaining two design patents upon a single fixture, but it is submitted that plaintiff's counsel, thoroughly familiar with plaintiff's patents, their file histories and the prior art, should have realized that defendant did not infringe and did not use essential elements of these design patents. Defendant therefore contends that plaintiff did not have a justifiable cause for prosecuting the action.

The Trial Court in the instant case took into consideration the fact that plaintiff charged defendant with infringement of patent No. 2,411,952 by notice in August, 1947 [Finding No. 2, R. 25]. **There was no basis for such charge** and plaintiff's own witness admitted that defendant did not use the construction covered by this patent [R. 176]. However, defendant was forced to study this patent, investigate the prior art, and prepare thereon. In June, 1948, the complaint filed by the plaintiff left out this mechanical construction patent No. 2,411,952 and limited the charge of infringement to the two design patents.

The complaint made unsupportable and unjustifiable allegations. For example, paragraph XIII of the complaint [R. 5] alleged that "plaintiff has placed the required statutory notice upon all lighting fixtures sold by plaintiff." However, upon trial, plaintiff's own witness, Kaepfel, admitted that the fixtures were not marked with patent numbers.

"Q. (By Mr. Miketta): Are there any patent numbers that are marked or engraved on that fixture?
A. There are none that I know of." [R. 96.]

Why did plaintiff make an unjustifiable allegation in its complaint regarding its own fixtures?

The record of this case further shows that plaintiff took depositions of five of defendant's officers and employees, which depositions were not introduced into evidence during the trial. The taking of these depositions caused defendant to incur loss of time and increased the expense imposed upon defendant.

The Trial Court had opportunity to observe the witnesses, to hear all of the arguments and to listen to and

weigh all of the contentions made. The Trial Court observed that plaintiff waited one year and nine months after the complaint was filed and waited until the plaintiff had closed its prima facie case before plaintiff amended its complaint to introduce a totally new charge, that of unfair competition.

Did the Trial Court abuse its discretion in mentioning this late charge in Finding of Fact 2 and in considering such tactics in awarding attorneys' fees?

Defendant's counsel filed an affidavit [R. 23-24] specifying the work done and the hours of time spent on this case. The legal services of defendant's counsel and his associate averaged about \$15 per hour in gross and amounted to \$6,240, with an additional \$684.13 for reporters' fees, exhibits, file histories, etc., making a total of \$6,924.13. The Trial Court awarded defendant only \$3,000 in attorneys' fees and reporters' fees and costs were taxed at \$388.99. Certainly this does not compensate defendant for the lost time, the disruption of defendant's normal business operations, the harmful effect on defendant's business due to knowledge by the trade that defendant was being sued by one of the most powerful companies in the lighting fixture industry. The Senate Report stated that the purpose of Section 70 was "* * * to prevent a gross injustice to an alleged infringer."

From the record in this case and from the findings of fact made by the District Court, it is evident that the Trial Judge had considered the tactics employed by plaintiff and the actual expenditures incurred and, in the Court's dis-

cretion, made an award of less than one-half of such actual expenditures. This was not an abuse of discretion.

“We think it clear that under the statute the question is one of discretion. The court exercised its discretion and that ends the matter, unless we can say, as a matter of law, that there was a clear abuse of discretion. This we cannot say.”

Blanc v. Spartan Tool Co., 168 F. 2d 296 (C. C. A. 7).

This Court, in the recent case of *Dubil v. Rayford Camp & Co.* (decided October 18, 1950, 87 U. S. P. Q. 143) had indicated that it is better practice for the Trial Court to make a specific finding as to the basis of its conclusion to award attorneys' fees. In the *Dubil* case the matter was complicated by the fact that Federal and non-Federal causes had been joined and there was no evidence to show how much of counsel's time had been spent on the non-Federal cause of action. Moreover, one of the defendants was not chargeable with elements of fraud. In the instant case the record is clear; non-infringement should have been apparent to skilled counsel for plaintiff; there was no excuse for the belated charge of unfair competition (apparently made in an attempt to catch defendant by surprise during trial); and the findings of fact and record disclose grounds upon which an award is justified. It is to be noted that the award is only one-fifth of that in the *Dubil* case.

It is therefore submitted that the findings justify the award, and adequately state a basis therefor.

SUMMARY AND CONCLUSION.

Defendant, Ruby Lighting Corporation, has presented FACTS, which clearly establish

- (1) that all lighting fixtures (from a date long prior to the filing of the patents in suit) have functional, necessary and common shapes and elements;
- (2) that the art has used such shapes and elements and must use them to get lighting efficiency;
- (3) that the patents in suit, if valid, are extremely limited;
- (4) that defendant has not used the purported ornamental features of the design patents in suit.

LAWPOINTS AND AUTHORITIES which establish

- (1) that design patents must be limited to what is shown in their drawings;
- (2) that the use of features common to articles of a class, particularly when such features are utilitarian, is free to all;
- (3) that to sustain an action for unfair competition plaintiff must prove palming off, deception of customers, or that the public associates the particular product with plaintiff as the source (*Kellogg Co. v. National Biscuit Co.*, 305 U. S. 111).

Defendant, Ruby Lighting Corporation, submits:

- (1) that plaintiff failed to show secondary meaning, palming off or deception;
- (2) that the Findings of the District Court adequately support the Judgment;
- (3) that the Judgment of the District Court be affirmed and the appeal dismissed, with costs to the defendant.

DATED: At Los Angeles, California, this 22nd day of December, 1950.

Respectfully submitted,

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Attorneys for Defendant-Appellee.

